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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,354	11/21/2003	William C. Maloney	K047 1140.2	3324
7590 11/21/2006			EXAMINER	
MARK A. TIDWELL JACKSON WALKER L.L.P. 112 E. PECAN, SUITE 2100 SAN ANTONIO, TX 78205			TRIEU, VAN THANH	
			ART UNIT	PAPER NUMBER
			2612	

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/719,354	Applicant(s) MALONEY, WILLIAM C.	
	Examiner Van T Trieu	Art Unit 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-36 and 38-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-36 and 38-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The Specification Amendment filed on 10/27/2006 is incorrect. The claimed priority should include "the continuation-in-part application of U.S. Application Serial No. 10/180,665, filed on 6/26/2002, now U.S. Patent No. 6,707,381, which claims the benefit of priority of U.S. Provisional Patent Application Serial No. 60/300,988, filed on 6/26/2001".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 31-33, 36, 38-43, 45-49, 54-66 and 68-76 are rejected under 35 U.S.C. 102(e) as being anticipated by **Singleton** US 7,116,228] claimed benefit of a provisional US application No. 60/269,808 filed on 2/20/2001.

Regarding claim 31, the claimed a key tracking and control system comprising: a storage unit defining an enclosed, internal space therein, the storage unit capable of being opened to access the internal space (the key asset management system for

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storing, locating and controlling of keys with RFID tags 11 within the security enclosure or storage cabinet or drawer 21 being accessed by a door, see Figs. 3-7, abstract, col. 5, lines 34-50 and col. 9, lines 27-57); and the plurality of receptacles defined within the enclosed, internal space, the receptacles disposed for receiving a plurality of trackable keys (the plurality of storage receptacles 18 for receiving and storing 256 key tags 11, see Figs. 1-4 and 9, col. 9, lines 27-45); and the plurality of trackable keys removably insertable into the receptacle without opening the storage unit wherein each trackable key is attached to a trackable RFID tag (each of the 256 keys is attached with RFID tags 11, see Figs. 1 and 2, col. 5, lines 14-33 and col. 9, lines 29-45); and the central controller remotely located from the storage unit (the local scanner 22 and/or local tag reader 26 is communicated with a remote external tag reader 27, remote controller computer, host computer or host PC over the LAN network or Web sites, see Figs. 3-11 and 13-19, col. 3, lines 40-67, col. 4, lines 1-2, col. 5, lines 51-67, col. 6, lines 1-34 and 53-65, col. 11, lines 43-67, col. 12, lines 1-6 and 46-52 and col. 13, lines 33-37).

Regarding claim 32, the claimed communication between the storage unit and the central controller (the local scanner 22 and/or local tag reader 26 is communicated with a remote external tag reader 27, remote controller computer, host computer or host PC over the LAN network or Web sites, see Figs. 3-11 and 13-19, col. 3, lines 40-67, col. 4, lines 1-2, col. 5, lines 51-67, col. 6, lines 1-34 and 53-65, col. 11, lines 43-67, col. 12, lines 1-6 and 46-52 and col. 13, lines 33-37).

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Regarding claim 33, the claimed communication link is a network connection (the LAN network or WEB sites, see Figs. 3-11 and 13-19, col. 3, lines 40-67, col. 4, lines 1-2, col. 5, lines 51-67, col. 6, lines 1-34 and 53-65, col. 11, lines 43-67, col. 12, lines 1-6 and 46-52 and col. 13, lines 33-37).).

Regarding claim 36, the claimed network connection is the Internet (the WEB sites).

Regarding claim 38, the claimed network connection is LAN (LAN network, see col. 11, lines 44-67)

Regarding claim 39, the claimed plurality of storage unit (the plurality of storages 21, see Figs. 3-7 and 13, col. 5, lines 45-49).

Regarding claim 40, the claimed storage unit comprises a local controller (the local scanner 22 or reader 26, see Figs. 13-19, col. 5, lines 53-67 and col. 6, lines 1-21).

Regarding claim 41, the claimed local controller is located in the storage unit (the local scanner 22 or reader 26, see Figs. 13-19, col. 5, lines 53-67 and col. 6, lines 1-21).

Regarding claim 42, the claimed local controller is remotely located from the storage unit and remotely located from the central controller (the scanner 22 can located on the

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walls or in filing cabinets remotely from the key storage drawer 21 and remotely from external reader or host PC, see Fig. 4, col. 9, lines 34-57 and col. 11, lines 44-67).

Regarding claim 43, the claimed local controller has a network connection (see col. 11, lines 44-67).

Regarding claim 45, the claimed local controller in communication with the central controller via the communication link (the local scanner 22 and/or local tag reader 26, is communicated with a remote external tag reader 27; remote controller computer, host computer or host PC over the LAN network or Web sites, see Figs. 3-11 and 13-19, col. 3, lines 40-67, col. 4, lines 1-2, col. 5, lines 51-67, col. 6, lines 1-34 and 53-65, col. 11, lines 43-67, col. 12, lines 1-6 and 46-52 and col. 13, lines 33-37).

Regarding claim 46, the claimed central controller is a control computer (the host computer or host PC, see Figs. 3-11 and 13-19, col. 3, lines 40-67, col. 4, lines 1-2, col. 5, lines 51-67, col. 6, lines 1-34 and 53-65, col. 11, lines 43-67, col. 12, lines 1-6 and 46-52 and col. 13, lines 33-37).

Regarding claim 47, the claimed local controller is a local computer (the local reader 26 having a controller software, see Fig. 3, col. 6, lines 1-21).

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Regarding claim 48, the claimed storage unit comprises a storage cabinet (the storage cabinet 21, see col. 5, line 40).

Regarding claim 49, the claimed each of the trackable objects is associated with an asset to be tracked (the key tags 11, see Figs. 1 and 2, col. 5, lines 12-32).

Regarding claim 54, all the claimed subject matters stated in respect to claims 31 and 36 above, and including the tangible object (the Figs. 3-7); and the array of adjacent sockets (the array of receptacles 18, see Figs. 1, 3-7 and 9).

Regarding claim 55, all the claimed subject matters are stated in respect to claims 31 and 36 above, and the fixed slots (the receptacles 18, see Figs. 1, 3-7 and 9).

Regarding claim 56, all the claimed subject matters are stated in respect to claims 46, 47 and 55 above.

Regarding claim 57, the claimed inventory system (the vehicle inventory, see col. 8, line 51).

Regarding claim 58, the claimed accounting system (the accounting, see col. 9, lines 22-24).

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Regarding claim 59, the method claimed limitations is stated in respect to the apparatus claims 31 and 50 above, and including the authentication a user checking-in and checking-out a particular trackable object from the user (see Figs. 18 and 19, col. 7, lines 50-67, col. 8, lines 1-67 and col. 9, lines 10-19).

Regarding claim 60, all the claimed subject matters are stated in respect to claims 42, 43 and 59 above.

Regarding claim 61, all the claimed subject matters are stated in respect to claims 43-47 and 59 above.

Regarding claim 62, the claimed transmitted alarm signal to the monitoring computer based on the unauthorized removing of the object from the storage unit (reads upon the alerting event, see col. 3, lines 56-65).

Regarding claim 63, the claimed transmitting alarm signal to the monitoring computer based on the tampering of the object (reads upon the alerting/warning event, see col. 3, lines 56-65).

Regarding claim 64 all the claimed subject matters are stated in respect to claims 36 and 59 above.

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Regarding claim 65, all the claimed subject matters are stated in respect to claims 35 and 59 above.

Regarding claim 66, all the claimed subject matters are stated in respect to claims 44 and 64 above.

Regarding claim 68, all the claimed subject matters are stated in respect to claims 62 and 59 above.

Regarding claim 69, all the claimed subject matters are stated in respect to claims 63 and 59 above.

Regarding claim 70, all the claimed subject matters are stated in respect to claims 63 and 59 above.

Regarding claim 71, all the claimed subject matters are stated in respect to claims 46, 57 and 64 above.

Regarding claim 72, all the claimed subject matters are stated in respect to claims 46, 58 and 64 above.

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Regarding claim 73, all the claimed subject matters are in stated in respect to claims 46, 56 and 64 above.

Regarding claim 74, all the claimed subject matters are stated in respect to claims 62 and 64 above.

Regarding claim 75, all the claimed subject matters are stated in respect to claims 36 and 71 above.

Regarding claim 76, the method claimed limitations are met by the apparatus claims 31, 50 and 54 above, and including the orientation feature so as to ensure that the security box is inserted into the storage unit in a proper orientation (the plastic rod of key tag 11 is oriented to be properly inserted into the receptacle 18, see Figs. 3-7 and 9, col. 5, lines 15-32, col. 9, lines 59-67 and col. 10, lines 1-3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 34, 35, 44, 50-53 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Singleton** [US 7,116,228] in view of **Frederick** [US 6,788,997]

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Regarding claim 34, **Singleton** fails to disclose the wireless communications link between the local controller and the central computer. However, **Singleton** teaches that the local scanner 22 and/or local tag reader 26 is communicated with a remote external tag reader 27, remote controller computer, host computer or host PC over the LAN network or Web sites, see Figs. 3-11 and 13-19, col. 3, lines 40-67, col. 4, lines 1-2, col. 5, lines 51-67, col. 6, lines 1-34 and 53-65, col. 11, lines 43-67, col. 12, lines 1-6 and 46-52 and col. 13, lines 33. **Frederick** suggests that the wireless communication for communicating to/from the storage, see col. 8, lines 44-64. Therefore, an artisan would substitute the wireless communication of **Frederick** for the communication links between the local scanner/reader and the external reader or remote host PC of **Singleton** for eliminating wires/cables and provides a greater convenience to users/customers, since the RF or satellite wireless communications links are well known and available in the communication networks.

Regarding claim 35, **Singleton** fails to disclose the communication link is wireless LAN. However, according to the combination between **Singleton** and **Frederick** in respect to claim 34 above, and furthermore, **Frederick** also teaches that the wireless communication is a LAN 82 or 328, see Figs. 13 and 40.

Regarding claim 44, the claimed storage unit comprises a wireless communication device is met by combination between **Singleton** and **Frederick** in respect to claim 34 above.

Regarding claim 50, all the claimed subject matters are cited in respect to claims 31, 41, 45 and 46 above, and including each trackable object having an upper portion and lower portion (each of the key having upper and lower portion for inserting into the receptacle 18 of storage drawer 21, see Figs. 1-7); and having an array of sockets individually defined within the storage unit in the same plane, each socket configured to receive the lower portion of a trackable object (the array receptacles 18, see Figs 3-7 and 9, col. 9, lines 34-45); and the claimed wireless communications links is met by the combination wireless communications links between **Singleton** and **Frederick**.

Regarding claim 51, all the claimed subject matters are discussed between **Singleton** and **Frederick** in respect to claims 36 and 50 above.

Regarding claim 52, all the claimed subject matters are discussed between **Singleton** and **Frederick** in respect to claims 38 and 50 above.

Regarding claim 53, all the claimed subject matters are discussed between **Singleton** and **Frederick** in respect to claims 39 and 50 above.

Regarding claim 67, the claimed storage unit comprises a wireless communication device is met by combination between **Singleton** and **Frederick** in respect to claim 34 and 59 above.

Response to Arguments

4. Applicant's arguments filed on 10 April 2006 have been fully considered but they are not persuasive. Because of the Amendment with new subject matters changes the scope of the claimed limitations. Therefore, a new reference of **Singleton** is with and/or without combination with **Frederick** to make the rejection smoother.

Conclusion

5. Examiner is very regrettably to withdraw the Final Rejection Office Action filed on 22 June 2006 due to the Amendment After Final and the update search.

6. Any inquiry concerning this communication or earlier communications from examiner should be directed to primary examiner **Van Trieu** whose telephone number is (571) 272-2972. The examiner can normally be reached on Mon-Fri from 7:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Mike Horabik** can be reached on (571) 272-3068.

A handwritten signature in black ink, appearing to read 'Van Trieu', with a long horizontal flourish extending to the right.

Van Trieu
Primary Examiner
Date: 11/16/06